

REMARKS/ARGUMENTS

Claims 1-7 and 9-20 are currently pending in the present application. Claim 8 has been canceled without prejudice or disclaimer. No new matter has been added. Reconsideration of the application is respectfully requested in view of the following remarks.

Objection to the Specification

The objection to the specification for use of a trademark is respectfully traversed. According to the Office,

the use of the trademark such as EcoPIA® on page 7, line 33 of the specification has been noted in various locations in the specification. It should be capitalized whenever it appears and be accompanied by the generic terminology.

Present Office Action at page 2, para. 1.

Applicant notes, however, that the trademark is recited in one location in the specification, at page 7, line 33, and is capitalized. Moreover, the trademark is accompanied by the generic terminology, which begins at page 7, line 30, referring to the hydroxy carboxylic acid.

Therefore, as the use of the trademark is proper, withdrawal of the objection is requested.

Rejection under 35 U.S.C. § 101

The rejection to claim 8 under 35 U.S.C. § 101 because the claimed recitation of a use is traversed and rendered moot in view of the cancellation of the non-statutory subject matter.

Rejection under 35 U.S.C. § 112

The rejection claim 8 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is traversed and rendered moot in view of the cancellation of the non-statutory subject matter.

Rejection under 35 U.S.C. § 103(a)

The rejection of claims 1-20 under 35 U.S.C. § 103(a) as obvious over Warzelhan et al. (US Patent No. 6,018,004) in view of Hager et al. (US Patent No. 5,373,058) is respectfully traversed.

The references do not describe or suggest a *biodegradable polyester mixture* comprising

- from 5% to 80% by weight, based on the total weight of components i to ii, of at least one polyester based on aliphatic and aromatic dicarboxylic acids and an aliphatic dihydroxy compound (component i) and
- from 20% to 95% by weight, based on the total weight of components i to ii, of at least one renewable raw material (component ii) *and*
- from 0.1% to 15% by weight, based on the total weight of components i to ii, of a glycidyl acrylate and/or glycidyl methacrylate as component iii.

See present claim 1. (Emphasis added).

Warzelhan et al. describes specific biodegradable polyester compositions, e.g., for producing biodegradable moldings and adhesives, biodegradable moldings, foams and blends with starch. However, as acknowledged by the Office, Warzelhan et al. does not describe, *inter alia*, the specifically claimed biodegradable polyester mixture having a glycidyl acrylate and/or glycidyl methacrylate as a component iii.

The Office uses Hager et al. for its general disclosure of “combining glycidyl acrylate with polyesters to improve the performance and reactivity of polyester(s),” and “making a mixture of polyesters and glycidyl acrylate and a glycidyl acrylate component at 6% by weight.” Present Office Action at page 4, para. 8.

However, Applicant points out that Hager et al. does not describe *biodegradable polyester* compositions. To the contrary, the reference describes unsaturated polyester resin compositions used in making sheet molding compounds (SMC), e.g., for valve covers and radiator supports. According to the reference, “certain glycidyl acrylates, when copolymerized with certain unsaturated polyesters, provide high performance, structural SMC products . . . One result has been ‘zero shrinkage’ parts,” and not biodegradable parts or biodegradable

compositions. Column 1, at lines 59 to column 2, line 9; see also Examples I to VI (description of formulations and parts).

As such, one would not be motivated to rely on Hager et al. to modify Warzelhan et al. or combine the disclosures to achieve the claimed invention, since there is no apparent reason or indication in Hager et al. to do so. Moreover, other than hindsight of the present specification, there is no indication that selectively choosing a glycidyl acrylate from Hager et al. would be effective for or combinable with starch or a renewable raw component for the achievement of a biodegradable polyester composition.

Therefore, the claimed *biodegradable polyester* composition is not obvious in view of the references of record. Accordingly, withdrawal of the rejection is requested.

In view of the foregoing, consideration and allowance are respectfully solicited.

In the event the Examiner believes an interview might serve in any way to advance the prosecution of this application, the undersigned is available at the telephone number noted below.

The Office is authorized to charge any necessary fees to Deposit Account No. 22-0185.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 12810-00192-US1 from which the undersigned is authorized to draw.

Dated: December 17, 2008

Respectfully submitted,

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